

**REMARKS**

This Amendment is filed in response to the non-final Office Action dated June 25, 2009, and is respectfully submitted to be fully responsive to the rejections raised therein. Accordingly, favorable reconsideration on the merits and allowance are respectfully requested.

In the present Amendment, claim 1 has been amended *inter alia* to recite that the pressure sensitive adhesive product comprises a support, and to recite the amounts of components (B) and (C) to be commensurate in scope with the working examples in the present specification. Support for the amendment to claim 1 can be found on page 8, line 34 to page 9, line 2; and also on page 13, lines 18-20, for example.

Claim 8 has been canceled.

Claims 9 and 10 are newly added and depend from claim 1. Support for claim 9 can be found in the specification on page 13, lines 30-32, for example. Support for claim 10 can be found in the specification on page 14, lines 22-29, for example.

No new matter has been added. Entry of the Amendment is respectfully submitted to be proper. Upon entry of the Amendment, claims 1, 3-7, 9 and 10 will be pending in the application.

**I. Response to Rejection Under 35 U.S.C. § 103(a)**

Claims 1 and 3-7 were rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over JP 05-302026 (Toda) in view of JP 05-059267 (Watabe).

Applicant respectfully traverses and requests that the rejection be withdrawn in view of the amendment to the claims and the following remarks.

As an initial matter, claim 1 has been amended to recite:

1. A pressure sensitive adhesive product comprising a support obtained by applying a pressure sensitive adhesive composition which comprises the following components (A), (B) and (C) to the support and thermally curing the pressure sensitive adhesive composition: (A) a hydrolyzable silyl group-containing organic polymer containing at least 1.3 hydrolyzable silyl groups per molecule and having a number average molecular weight of 20,000 to 50,000, the main chain of the organic polymer being substantially composed of a repeating unit or units represented by the general formula  $-R^1-O-$  ( $R^1$  being a divalent alkylene group); (B) a hydrolyzable silyl group-containing organic polymer containing 0.3 to 1.3 hydrolyzable silyl groups per molecule and having a number average molecular weight of 3,000 to 10,000, a compounding ratio of which is 1 to 100 parts by weight relative to 100 parts by weight of (A), and the main chain of which polymer being substantially composed of a repeating unit or units represented by the general formula  $-R^1-O-$  ( $R^1$  being a divalent alkylene group); (C) a tackifier resin selected from the group consisting of terpene resins, terpene phenol resins, petroleum resins, rosin ester resins, and admixtures thereof, and a compounding ratio of which is 30 to 100 parts by weight, relative to a combined total of 100 parts by weight of (A) and (B). Thus, the presently claimed invention, as amended, is directed to a pressure sensitive adhesive product which comprises a support and is obtained by applying the pressure sensitive adhesive composition on the support and thermally curing the composition. The support and the cured composition are used together as a pressure sensitive adhesive product.

Toda alone or combined with Wataba fails to teach the presently claimed invention as recited in amended claim 1. On the contrary, the compositions of Toda and Watabe are directed to sealing materials used for the filling of gaps, such as joints, which are caused by temperature

changes causing extension and contraction of an adherend. Toda and Watabe fail to teach a support and a cured composition. Accordingly, the references do not teach or suggest each feature/limitation of the presently claimed invention.

Secondly, Applicant respectfully submits that sealing materials do not have high adhesive strength (tack strength), and since adhesive property is poor a person having ordinary skill in the art cannot create a pressure sensitive adhesive product from such teachings directed to sealing materials. That is, even if in the case of resealable sealing materials, these materials have only weak adhesive strength (i.e., tack strength), which is a distinguishable difference between sealing materials and pressure sensitive adhesive products. Sealing materials do not and are not expected to have a high adhesive strength, otherwise they do not function as sealing materials, since antifouling property is poor in case they have a high adhesive strength. Pressure sensitive adhesive products, on the other hand, have a high adhesive strength. Otherwise they do not function as pressure sensitive adhesive products, since the adhesive property is poor in case they have low adhesive strength (i.e., tack strength). Therefore, those skilled in the art cannot create a pressure sensitive adhesive product from such teachings directed to sealing materials.

Next, the Examiner asserted the position that Toda and Watabe render obvious the claimed ingredients and claimed amounts, and that the compositions would be capable of serving as pressure-sensitive products. The Examiner further asserted that many sealant compositions benefit from having the ability to reseal. (*See* “Response to Arguments” in the Office Action dated June 25, 2009).

Applicant respectfully disagrees.

Even assuming, *arguendo*, that one having ordinary skill in the art would be motivated from the teachings of Toda and Watabe to combine the polymer (A) with the polymer (B), which

they would not, it is unpredictable that the combination provides such a large adhesive strength (i.e., tack strength), since both references are directed to sealing materials. Assuming that *prima facie* obviousness has been established, which it has not, the burden of proffering rebuttal evidence is shifted to the patent applicant. (*See Süd-Chemie Inc. v. Multisorb Technologies Inc.*, 554 F.3d 1001, 89 USPQ2d 1768, 1774 (CAFC 2009)). Said evidence and arguments may be presented in the specification. (*In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684 (Fed. Cir. 1995)). A specification that contains more than a mere conclusory assertion of unexpected results is pertinent evidence. (*Id.*) The Examiner is obliged to consider all rebuttal evidence, and evidence that the claimed invention yields unexpectedly superior or improved properties not present in the prior art must be considered. (*Id.* at 1687; *see also In re Dillion*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)).

The composition of Comparative Example 2 of the present application corresponds to the composition of Toda. The composition does not contain the polymer (B), and the adhesive strength is only 10.2 N/25mm, although the amount of tackifier resin is as large as 100 weight parts. The composition of Comparative Example 3 contains the polymer (A-3), which has a number average molecular weight as low as 10,800, and the adhesive strength is only 9.8 N/25mm, although the amount of tackifier resin is as large as 8010 weight parts. A person having ordinary skill in the art would not expect from these compositions that a combination of two different polymers, one having a high number average molecular weight, and the other having a low number average molecular weight would, provide a high adhesive strength, since these polymers independently provide a very low adhesive strength.

Comparing Example 1 (adhesive strength: 30.6 N/25mm) or Example 2 (adhesive strength: 25.4 N/25mm) with Comparative Example 2, it is clearly shown that adding a certain

amount of the polymer (B) to the polymer (A) doubles or triples the adhesive strength (i.e. tack strength) of the cured product although, surprisingly, the amount of tackifier resin is reduced. The amount of the tackifier is large compared with ordinary sealing material composition, but it is very low for the pressure sensitive adhesive products.

Furthermore, the scope of claim 1 as amended is commensurate with Examples of the specification. Claim 1 as amended specifically recites the amount of component (8), as well as the amount of (C), the range of which has been limited. The number average molecular weights of polymers have also been amended.

It should also be noted that although Toda teaches that the preferable range of the molecular weight of polymer (a) is 4,000 to 30,000, Toda uses a polymer having a molecular weight of 8,500 in Examples (paragraph [0026]). Although Toda teaches a wide range of molecular weight, those skilled in the art would interpret that a molecular weight of approximately 8,500, which is much lower than the presently claimed range (20,000 to 50,000) of the present invention, would be most preferable for the composition of Toda. The combination of polymers (A) and (B) of the present invention are not rendered obvious from the cited references.

In view of the above, the presently claimed invention of claim 1 is not obvious over the cited references. Claims 3-7, 9 and 10 depend from claim 1, and are patentable over the art for at least the reasons mentioned with respect to claim 1. Accordingly, withdrawal of the § 103(a) rejection based on Toda and Watabe is respectfully requested.

**II. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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